

## **REMARKS/ARGUMENTS**

The December 22, 2008 Office Action has been reviewed in detail. Pending Claims 1-4, 8, 10-11, 27 and 34-52 were rejected under 35 U.S.C. § 101 in view of the recent Federal Circuit decision *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008). As described in detail below, the claims in the present application transform a physical article into a different state and therefore satisfy the machine-or-transformation test set forth in *Bilski*. Withdrawal of the Section 101 rejections and allowance of the pending claims is respectfully requested.

A claimed process is patent-eligible subject matter under Section 101 when the process transforms a particular article into a different state. *Bilski*, 545 F.3d at 954. Notably, the process claims in the present application recite, in general, steps wherein manufacturers submit a product or product sample having at least one color to a governing body for assignment of an identification code corresponding to the color of the product. The governing body likewise assigns identification codes to other products submitted by other manufacturers. Equipped with this information, manufacturers are then able to label products with the corresponding identification codes such that consumers can color match the products based on the identification codes affixed to the manufactured products. *Bilski* simply requires that the process “transform[] a particular article into a different state”. *Id.* In this regard, the color matching and coordinating reference system transforms physical subject matter (i.e. an “article” such as manufactured products) from one state (i.e. unlabeled and unidentified) to another state (i.e. labeled and identified) by labeling the products with the identification codes from the governing body.

“It is virtually self-evident that a process for a . . . physical transformation of physical objects . . . is patent-eligible subject matter.” *Bilski*, 545 F.3d at 962. The labeling of the manufactured products enabled through the submitting and assigning steps described above falls squarely within this realm of patent-eligible subject matter. The claims carve out scope and content, not related to the “manipulation of . . . abstract constructs such as legal obligations, organizational

relationships, [or] business risks,” but rather the physical identification state of the manufactured products. *Id.* Color information related to the manufactured product is derived from a finite selection of colors within the visible color spectrum. The claims seek not to pre-empt all uses of the color spectrum (an otherwise fundamental principle inherent in the properties of electromagnetic radiation wavelengths), but the application of those principals to the color matching and coordinating reference system that results in the labeling of actual physical products such that consumers may coordinate colors among these products. *Id.* (limiting a claimed process “to a practical application of a fundamental principle . . . [eliminates any] danger that the scope of the claim would wholly pre-empt all uses of the principle”).

Furthermore, the labeling steps that transform the manufactured products from a first unlabeled and unidentified state, to a second labeled and identified state also satisfies the other general patent-eligibility considerations set forth in *Bilski*. 545 F.3d at 961. For example, the transformation must impose a meaningful limit on the scope of the claims to impart patent-eligibility. *Id.* Here, the labeling steps are absolutely necessary to the operation of the color matching and coordinating reference system. A reference system existent without labeled products is of no utility. Likewise, a “labeled” product without the reference system created by the governing body is also useless. Obviously, the reference system is intricately intertwined with the labeling of the manufactured products with the color identification codes. It is self-evident that an unlabeled and unidentified manufactured product is not capable of being transformed to a labeled and identified product without performing the aforementioned submitting and assigning steps. A reference system existent without actually labeling the products does not impose meaningful limitations on a claim and vice versa.

Another *Bilski* consideration requires that the limitation must not merely be an insignificant extra-solution activity. 545 F.3d at 962. That is, the “transformation must be central to the purpose of the claimed process.” *Id.* Naturally, the intricate intertwinement of the reference system with the labeled state of the manufactured products necessarily requires that such steps (i.e. the

labeling steps) are not merely insignificant extra-solution activities. Obviously, the transformation of a manufactured product from one state that does not include an identification code to a second state that includes an identification code is certainly central to the color matching and coordinating reference system. As described above, a reference system that does not label associated tangible products is of no use in the physical world. Conversely, the reference system can not be created without the existence of such tangible products. Hence, the labeling steps that transform an otherwise unlabeled and unidentified product into one that is labeled and identified is not merely an insignificant extra-solution activity, but a step required for the color matching and coordinating reference system to work. This is the very type of process claim *Bilski* endeavored to include as patent-eligible subject matter through some transformation of an article in the physical world. *Bilski*, 545 F.3d at 963. (A “claim process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article”.).

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the Section 101 rejections. Notably, the color matching and coordinating reference system transforms manufactured products from one state to another. Without the transformation, the reference system is useless and, without the reference system, the labels are useless. In this regard, the labeling steps impose meaningful and necessary limitations such that the claims fall within the scope of patent-eligible subject matter under *Bilski*. Thus, a Notice of Allowance for all pending claims is respectfully requested.

Respectfully submitted,

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